

REMARKS

I. Introduction

The Current Action:

determines claims 25-29 to be directed to a non-elected invention and withdraws them from consideration;

rejects claims 21-24 under 35 U.S.C. § 112(2);

rejects claims 21, 22, and 24 under 35 U.S.C. § 102(b);

rejects claims 21-24 under 35 U.S.C § 103(a).

The Applicants respectfully submit that all rejections of record are traversed by the remarks below, and respectfully ask the Examiner to withdraw the rejections of record. Claims 21-29 remain pending in the present application.

II. The Withdrawal from consideration of Claims 25-29

The Current Action concludes that claims 25-29 are drawn to a non-elected invention, and, as a result, withdraws them from consideration. The Applicants respectfully assert, however, that on its face the restriction requirement of the Current Action is improper. At page 2, the Current Amendment states:

Newly submitted claims 25-29 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons: claims 21-24 are drawn to a subcombination covering a single confirmation step in combination with a feedback re-determining quantity step whereas claims 25-29 are drawn to a dual confirmation request step method in combination with a single step quantity determination step. As such, the claims are subcombinations useable together.

The Applicants respectfully remind the Examiner that there are two criteria for a proper requirement for restriction: (A) the inventions must be independent or distinct as claimed; *and* (B) there must be a serious burden on the examiner if restriction is required. Further, such a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a

different field of search. *See* M.P.E.P. § 808.02. The Applicants respectfully point out that the Current Action makes no showing at all of a burden on the patent office. Without such a showing the restriction requirement is improper, and the Applicants respectfully ask the Examiner to withdraw the restriction.

In addition, the Applicants respectfully assert that the Examiner's own characterization would preclude restriction. As mentioned above, the Current Action contends that restriction is appropriate because claims 21-24 and claims 25-29 are "subcombinations useable together." (Current Action, pg 2). The Applicants respectfully submit that the Examiner's characterization of the claims is incorrect. Nevertheless, even if the Examiner's characterization of the claims could be supported, the Examiner's own description proves that restriction between the claimed groups is inappropriate. The Examiner describes claim 21 as comprising a "single confirmation step" and claim 25 as comprising a "dual confirmation step." (Current Action, pg. 2). Thus, as characterized by the Examiner, claim 21 would cover a single, dual, or multiple confirmation step, and would in fact be generic to the Examiner's articulation of claim 25. Therefore, while the Applicants do not concede that the Current Action's characterizations are accurate, the Applicants respectfully assert that those same characteristics preclude the restriction of these claims under M.P.E.P. § 806.04(d). As such, the Applicants respectfully request that that the restriction be withdrawn.

III. Rejections Under 35 U.S.C. § 112(2)

Claims 21- 24 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 21 is deemed indefinite for: 1) reciting "performance" and 2) not stating a specific use of quality or standards to quantify this term. However, the item indicated by the Examiner is a recitation that the Applicant has intentionally made broad. Claim 21 relates to determining a quantity of material using feed back relating to a performance of supply chain participants. "Performance" covers supply chain participants' usage rate or anything else within the scope of the claim; and, intentionally, is not limited to any one specific standard or quality. The Applicants respectfully remind the Examiner that breadth is not indefiniteness, see M.P.E.P. § 2173.04, and that while the specifics of the limitation may be left unrestricted, the scope of the subject matter embraced by claim 21 is quite clear. This clarity is all that the M.P.E.P. requires. The Applicants respectfully assert that the language of claim 21 fully

articulates the scope of performance, and respectfully asks the Examiner to withdraw the rejection.

As each element of indefiniteness cited by the Current Action has been addressed, the Applicants respectfully request the rejection of claims 22-24 (which depend from claim 21) under 35 U.S.C. § 112, second paragraph be withdrawn.

V. Rejections Under 35 U.S.C. § 102(b)

The Current Action rejects claims 21, 22, and 24 as anticipated by Graves, et al., United States Invention Registration No. H1743 (hereinafter *Graves*). To be anticipatory, however, M.P.E.P. § 2131 requires that the reference teach each and every element of a rejected claim. Claim 21 recites “using feedback relating to a performance of at least one supply chain participant.” The Examiner attempts to meet this limitation citing, column 17 lines 28-37 of *Graves*, which teaches “a feedback process used to re-calculate projected tank levels.” (See *Graves* col. 3, lines 32-34). But this feature does not teach the limitation of claim 21, instead, this feature of *Graves* merely monitors the level of a storage tank and compares it to projected levels. Such a comparison provides no information regarding the performance of a supply chain participant. The Examiner further asserts that “the one supply chain participant is the customer and ‘performance’ is the functioning of the facility which as a result draws down on the tank supply.” (Current Action, pg. 4, lines 1-3). Even if the level in the storage tank could be considered a “performance,” and the Applicant does not concede that it could, nothing about monitoring the level pertains to the performance of at least one supply chain participant. A comparison of an actual level in a tank to a level that was projected monitors how the tanks is used- not how it is supplied. Therefore, the Applicants respectfully submit that claim 21 is patentable, and ask the Examiner to withdraw the rejection.

Claims 22 and 24 depend from independent claim 21, and thus inherit all limitations of claim 21. Each of claims 22 and 24 set forth features and limitations not recited by *Graves*. As such, the Applicants respectfully assert that for the above reasons, claims 22 and 24 are patentable over the 35 U.S.C. § 102 rejection of record.

VI. Rejections Under 35 U.S.C. § 103(a)

Claims 21-24 have been rejected as obvious over *Graves* in view of U.S. Patent No. 6,816,839 to Gung et al (hereinafter “*Gung*”). However, this rejection made by the Current Action does not meet the requirements for an obviousness rejection under 35 U.S.C. § 103(a).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

It is well established that when a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). With respect to claim 21, the Examiner asserts that “it would be obvious to modify *Graves* [according to *Gung*] to use a performance factor to determine supply forecasting because factors, such as, transporting reliability, and raw material availability would be considered.” (Current Action, pg 4). The Applicants respectfully point out that modifying *Graves* according to *Gung* would render *Graves* unsatisfactory for its intended purpose; therefore, the Examiner’s proposed combination does not comport with the requirements of M.P.E.P. § 2143.01.

Gung describes a forecast system that attempts to determine the number of component parts needed for a final product by “forecast[ing] sales volume...by combining methodologies of statistical forecasts, categorical data analysis, and information theory. (see *Gung* col. 3, lines 7-8; col. 3, lines 22-24). The forecast model of *Gung* is largely based on abstract, speculative values. In contrast, *Graves* presents a system wherein the actual, or real time, amount of consumable materials is tracked in an attempt to ensure a sufficient supply of the needed materials. Modifying the real time evaluation system of *Graves* to have the speculative forecast model of *Gung* would prohibit *Graves* from keeping track of consumable materials in real time. Such a modification would limit *Graves* only to forecast, or speculate, as to how much consumable materials would be needed in the future. Modifying *Graves* in this way would render it unfit for its intended purpose. Without proper motivation, the

Current Action has failed to establish a prima facie case for rejecting claim 21, and the Applicants respectfully ask the Examiner to withdraw the rejection.

In addition, the Examiner's proposed combination does not teach all of the limitations of Applicant's claimed invention. The Examiner relies on *Gung*, at col. 3 lines 16-19, to disclose "forecasting demand based upon performance." The Applicants respectfully remind the Examiner that the claim limitation reads "re-determin[ing] said required quantity using feedback relating to a performance of at least one supply chain participant," which *Gung* does not teach. Rather, *Gung* discloses adjusting forecast demand based on "external constraints including price change, inventory status, and competitors performance," (*Gung* col. 3, lines 16-19) which is not the same as "forecasting demand based upon performance." The proposed combination fails to teach or suggest all the limitations of claim 21. As such, the Current Action has failed to establish a prima facie case. The Applicants respectfully ask the Examiner to withdraw the rejection.

Claims 22-24 depend from claim 21, and thus inherit all limitations of claim 21. Although each of claims 22-24 recite limitations that make each patentable in their own right, each of claims 22-24 is patentable at least for depending from a patentable base claim. Therefore, the Applicants respectfully ask the Examiner to withdraw the 35 U.S.C. 103(a) rejection of record.

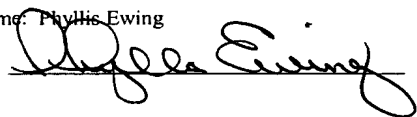
VII. Summary

In view of the above amendment, applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10004991-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail, Airbill No. EV 629198147 US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: 07/07/2005

Typed Name: Phyllis Ewing

Signature: 

Respectfully submitted,

By 

Michael A. Papalas

Reg. No.: 40,381

Date: 07/07/2005

Telephone No. (214) 855-8186